

1 **REMARKS**

2 Amendments to the Claims:

3 No amendments have been made to the claims, and no claims have been
4 canceled or added.

5 Petition for Extension of Time:

6 The Applicant herewith petitions the Commissioner of Patents and
7 Trademarks to extend the time for reply to the Office action dated 01/19/2005 for
8 one (1) month from 04/19/2005 to 05/19/2005. Please charge the deposit account
9 number 08-2025 in the amount indicated on the attached Transmittal Letter to cover
10 the cost of the extension. Any deficiency or overpayment should be charged or
11 credited to the above numbered deposit account.

12 Submission of Information Disclosure Statement (IDS):

13 The Applicant has submitted, as attached hereto, an IDS along with a form
14 PTO/SB/08A (08-03), which cites the single PCT international publication number
15 WO 02/089130 A1.

16 Rejection of Claims Under 35 U.S.C. § 103:

17 Claims 21, 24, 26-28, and 31 have been rejected under 35 U.S.C. 103(a) as
18 being unpatentable over U.S. Patent 6,731,455 to Kulakowski et al. ("Kulakowski") in
19 view of U.S. Patent 5,329,412 to Stefansky.

20 Claims 21 and 26 are independent claims, claim 24 depends from claim 21,
21 and claims 27, 28, and 31 depend from claim 26. Thus, if claim 21 is allowable, then
22 claim 24 is allowable, and if claim 26 is allowable, then claims 27, 28, and 31
23 are allowable.

24 The Examiner contends that Kulakowski discloses a data storage library per
25 claimed invention, including a storage library capable of handling tape cartridges or a
combination of tape and hard disk drive devices (the Examiner cites column 11, lines
21-47 of Kulakowski).

The Examiner contends further that Kulakowski is silent as to the HDD having
a form factor in the shape of a tape cartridge, and that Stefansky teaches a hard disk

1 drive device housing having the dimensions of a tape cartridge (the Examiner cites
2 column 1, lines 55-61 of Stefansky).

3 The Examiner also asserts that it would have been obvious to one having
4 ordinary skill in the art at the time the invention was made to have the housing
5 dimension of Kulakowski, which coincides with the housing dimension of a magnetic
6 tape cartridge, and that it would have been obvious for one of ordinary skill in the art
7 to have provided the HDD of Kulakowski with a housing having the same dimension
8 of a magnetic tape housing because such HDD cover had been known in the art, as
9 demonstrated by Stefansky.

10 The Applicant argued previously, and continues to maintain, that the
11 Examiner has not established a *prima facie* case of obviousness with respect to any
12 of the claims at least because:

- 13 1) there is no suggestion or motivation, either in the references themselves or
14 in the knowledge generally available to one of ordinary skill in the art, to
15 modify the references or to combine the reference teachings;
- 16 2) there is no reasonable expectation for success; and,
- 17 3) the references do not teach or suggest all the claim limitations.

18 That is, the Applicant previously argued, and continues to maintain, that none of the
19 above three requirements of a *prima facie* case of obviousness have been
20 established for any of the Applicant's claims.

21 The Applicant argues that the lack of suggestion or motivation to combine the
22 reference teachings, and the lack of reasonable expectation for success, are
23 evidenced at least by the fact that Kulakowski teaches only a symmetrical, dual-
24 ended cartridge (in which the data storage media can be accessed from two
25 opposite ends), and by the fact that Stefansky teaches only an asymmetrical disk
26 cartridge in which the cover "bulges outwardly" on one end, while it is "generally flat"
27 on the other end. (Stefansky, col. 5, lines 40-44.).

28 That is, Kulakowski teaches a library system with a picker that is configured to
29 be used only with dual-ended cartridges, wherein the cartridge is substantially
30 symmetrical such that each end is essentially identical with the opposite end. In this
31 manner, the dual-ended cartridge of Kulakowski can be gripped by the picker from
32 either end. However, Stefansky discloses no more than an asymmetrical cartridge
33 that has one rounded, or bulging, end and an opposite flat end, and which can only

1 be accessed from one end or one side. The teachings of Kulakowski depend on the
2 use of symmetrical, dual-ended cartridges, and therefore, Kulakowski teaches away
3 from what is taught by Stefansky, which is the use of an asymmetrical, single-ended
4 cartridge having one rounded, bulging end, and an opposite flat end.

5 Kulakowski reiterates in numerous locations a dual-ended cartridge:

6 In the described implementations, the storage device
7 comprised a dual-end hard disk drive. In alternative
8 implementations, the storage device may comprise any
9 storage device known in the art maintained in a housing that
10 provides non-volatile storage of data that can be accessed
11 from different locations or ends on the housing including the
12 storage medium ... such as an electronic storage device,
13 etc.” (Kulakowski, col. 11, line 63, through col. 12, line 6,
14 emphasis added.)

15 [B]ecause the disk drives are dual-end, they can be
16 swapped between pickers without the need to rotate the
17 hard disk drive or interrupt the I/O flow. For instance, when
18 swapping a dual-end hard disk drive between pickers, both
19 pickers can be engaged with the data interfaces at opposite
20 [ends] of the hard disk drive. This allows pickers to swap a
21 hard disk drive and time the disengagement of one picker to
22 minimize any interruption to data flow. Pickers on the same
23 track may also swap hard disk drives to avoid collisions. Still
24 further, the dual-end hard disk drives would not have to be
25 rotated in either an Input/Output station or pass-through
station between library modules because they may be
engaged from either end. (Kulakowski, col. 11, lines 7-19.)

Therefore, in view of the fact that Stefansky teaches an asymmetrical cartridge that cannot be accessed from more than one side, while Kulakowski teaches a symmetrical, dual-ended cartridge and a library system of which the

1 operation depends on the use of such dual-ended cartridges, it follows that there is
2 no suggestion or motivation, nor is there any reasonable expectation for success, to
3 combine the teachings of Kulakowski with the teachings of Stefansky, as is required
4 for an obviousness rejection.

5 In regard to the Applicant's argument that the references do not teach or
6 suggest all the claim limitations, the Applicant notes that the Examiner's rejection
7 depends on the Examiner's contention that Stefansky discloses a hard disk drive
8 device housed in a cover that has the **dimensions** of a tape cartridge.

9 The Applicant argues, however, that a cover that has the dimensions of a
10 tape cartridge is **not** equivalent to a housing having a tape cartridge form factor
11 suitable for use with a mechanical picker, nor is it equivalent to an exterior cartridge
12 shell shaped to have a tape cartridge form factor, the cartridge shell adapted to be
13 gripped and moved with a robotic gripper, as is claimed by the Applicant in claims 21
14 and 26, respectively.

15 That is, specifically, none of the cited prior art references teach or suggest a
16 housing having a **tape cartridge form factor** and a hard disk drive contained within
17 the housing, as is required by claim 21.

18 The Applicant notes that words of a patent must be given their plain meaning
19 (see MPEP 2111.01: Claim terms have ordinary and custom meaning per one of
20 ordinary skill in the art.). In this regard, Webopedia (www.webopedia.com) is an
21 online dictionary dedicated to defining computer technology. Per Webopedia, the
22 term "form factor" means: "The physical size and shape of a device." Thus, the term
23 "form factor" means both size **and** shape. Stefansky discloses a hard disk drive that
24 has only one dimension (i.e., the height) of a tape cartridge. (Stefansky, col. 1, lines
25 60-61.) Stefansky does not disclose a hard disk drive that has both the size **and**
shape of a tape cartridge.

Further, the fact that a given cartridge has certain "dimensions" does not imply
that the given cartridge is "suitable for use with a mechanical picker" or that the given
cartridge is "adapted to be gripped and moved with a robotic gripper" as is claimed
by the Applicant. In fact, Stefansky does not teach or suggest a cartridge suitable for
use with any type of picker or gripper. Thus, Kulakowski and Stefansky do not teach
or suggest all of the limitations of the Applicant's claims, as is required for a *prima*
facie case of obviousness.

1 Moreover, the Applicant maintains that the Examiner is misconstruing what
2 Kulakowski discloses. The Examiner contends that Kulakowski discloses "a storage
3 library capable of handling tape cartridges or a combination of tape and hard disk
4 drive devices" (the Examiner cites column 11, lines 21-47 of Kulakowski). However,
5 as is explained herein above with reference to the passage from Kulakowski (col. 11,
6 line 63, through col. 12, line 2), Kulakowski suggests that tape cartridges cannot be
7 used in a manner consistent with the recitations of the claims, which include *dual-*
8 *ended* cartridges.

9 Furthermore, the passage of Kulakowski cited by the Examiner as disclosing
10 the use of tape cartridges (col. 11, lines 21-47,) in fact does not disclose or suggest
11 the use of tape cartridges. On the contrary, the cited passage only teaches that
12 "[t]he preferred embodiments may be implemented as [an]...article of manufacture
13 [wherein] the term 'article of manufacture' as used herein refers to code or logic
14 implemented in ... a computer readable medium (e.g. magnetic storage medium,
15 hard disk drives, floppy disks, tape, etc.)" [Emphasis added.] Thus, the passage
16 merely teaches that embodiments in Kulakowski can be in the form of programming
17 code or logic for an operating system that is stored on tape. The cited passage does
18 not teach or suggest in any way the use of tape cartridges for use with a
19 library system.

20 In short, the cited references (Kulakowski and Stefansky) do not teach or
21 suggest all of the claim limitations, as is required for an obviousness rejection. None
22 of the requirements for a *prima facie* case of obviousness have been met with regard
23 to each of the Applicant's claims. Accordingly, the Applicant respectfully requests
24 that the final rejections of claims 21, 24, 26-28, and 31 be withdrawn and that those
25 claims be allowed.

22 SUMMARY

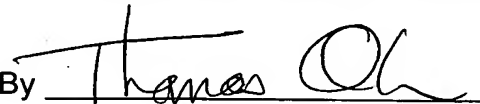
23 The Applicant believes this Submission for a Request for Continued
24 Examination under 37CFR1.114 constitutes a full and complete reply to the Final
25 Rejection mailed on 11/23/2005. The Applicant further believes that claims 21, 24,
26-28, and 31 are not obvious in view of the cited prior art references, and are
therefore in allowable form. The Applicant therefore believes that the application is

1 in condition for allowance, and requests timely allowance of claims 21, 24, 26-28,
2 and 31.

3 The Examiner is respectfully requested to contact the below-signed attorney if
4 the Examiner believes this will facilitate prosecution toward allowance of the claims.

5 Respectfully submitted,
6 Stephen V. Deckers, Applicant

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8 Date: April 29, 2005

By 

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